

Response Under 37 CFR 1.116
Expedited Procedure
Group Art Unit: 3732

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Pekka VALLITTU et al.

Serial Number: 10/557,822

Group Art Unit: 3732

Filed: November 23, 2005

Examiner: Mai, Hao D.

For: A MATRIX BAND

PETITION FOR WITHDRAWAL OF FINALITY OF OFFICIAL ACTION

Commissioner for Patents
ATTN: Technology Center Director
P.O. Box 1450
Alexandria, VA 22313-1450

March 28, 2008

Sir:

Applicants petition for withdrawal of the finality of the Official Action mailed November 28, 2008. The facts supporting this Petition follow:

1. This application is a U.S. National Stage of International Application PCT/FI2004/000308. Original claims 1-7 were directed to a matrix band; claims 8-10 were directed to a dental restoration kit; claim 11 was directed to a prepreg; and claims 12-15 were directed to the use of the matrix band of claim 1.

2. The Patent Office did not restrict the application prior to issuance of a first Official Action on June 12, 2007.

3. The Patent Office did not include a restriction requirement in the first Official Action. Instead, each of the pending claims 1-15 were examined on the merits.

4. An Amendment filed September 11, 2007 canceled claims 10-15, amended claim 1, and added new method claims 16-19 corresponding to canceled "use" claims 12-15.

5. A second Official Action, mailed November 28, 2007, imposed a restriction requirement between claims 1-9 and method claims 16-19, constructively elected claims 1-9, and withdrew claims 16-19 from further consideration. Claims 1-9 were rejected as obvious, and the Official Action was made "final".

ARGUMENT

The finality of the second Official Action is premature and should be withdrawn because the Official Action contains an improper¹ restriction requirement. No clear issue has been developed between the Examiner and the applicant with respect to withdrawn claims 16-19.

I. The Final Rejection Contains A Restriction Requirement

37 C.F.R. § 1.499 requires an examiner to impose restriction before final action. Accordingly, the finality of the second Official Action is premature.

II. No Clear Issue Has Been Developed Concerning Claims 16-19

MPEP § 706.07 requires a clear issue must be developed between the Examiner and the applicant before a Final Rejection is

¹The restriction requirement is improper because it applies U.S. restriction practice rather than PCT lack of unity of invention rules. A detailed traversal of the restriction requirement is contained in the accompanying Request for Reconsideration, and is incorporated by reference herein.

justified. In this case, making the second Official Action "Final" is premature because claims 16-19 (a) are properly part of the originally presented invention in the application, and (b) have not been examined.

The restriction requirement was imposed because method claims 16-19 were allegedly not part of the originally presented invention. However, method claims 16²-19 correspond to "use" claims 12³-15, which were searched and examined in the first Official Action. Accordingly, method claims 16-19 are properly part of the originally presented invention, and should not have been withdrawn from examination based on a constructive election. Instead, these claims should have been either examined or properly restricted *before* the Official Action was made final.

ACTION REQUESTED

The Patent Office is requested to withdraw the finality of the second Official Action and to either examine claims 16-19 or impose

²Claim 16. A method for the fabrication of a dental restoration comprising the steps of
drilling a cavity in a tooth to be repaired,
etching or priming the surface of said tooth,
applying a matrix band of claim 1 around said tooth, and
filling said cavity with restorative material.

³Claim 12. Use of a matrix band according to claim 1 for the manufacturing of a dental restoration, a dental bridge or a dental crown.

U.S. Appln. S.N. 10/557,822
PETITION FOR WITHDRAWAL OF FINALITY OF OFFICIAL ACTION

PATENT

a proper restriction requirement which permits the applicants to elect which claims to continue to prosecute in this application.

It is not believed any fee is required for entry and consideration of this Petition. However, the Patent Office is authorized to charge any such required fee to Deposit Account No. 50-1258.

Respectfully submitted,

/James C. Lydon/

James C. Lydon
Reg. No. 30,082

Atty. Case No.: **TUR-173**
100 Daingerfield Road
Suite 100
Alexandria, Virginia 22314
Telephone: (703) 838-0445
Facsimile: (703) 838-0447